REMARKS

Initialed Copy of PTO/SB/08 Form filed April 14, 2004

On review of the Office Action, Applicant notes that the Examiner has not attached an initialed copy of the PTO/SB/08 form filed with the application on April 14, 2004. Applicant further notes that the PTO's PAIR system indicates that the form is in the Image File Wrapper system, so Applicant respectfully requests that the Examiner consider the disclosed information and return an initialed version of the form with the next communication from the PTO.

Double Patenting Rejection under 35 U.S.C. 101

On page 2 of the Office Action, in paragraph 2, claims 1-11 are rejected under 35 U.S.C. 101 for double patenting as claiming the same invention as that of claim 9 of prior U.S. Patent No. 6,777,174.

In response, Applicant notes that MPEP 804 II.A. sets forth that in determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel,* 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

MPEP 804 II.A. indicates that a reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a

corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Namely, is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine."

Thus, Applicant wishes to point out that claims 1-11 of the present application do not claim the same invention as claim 9 of the '174 patent, because the subject matter of present claims 1-11 is **not identical** to that of claim 9 of the '174 patent. In this regard, claim 9 of the '174 patent requires that a total gelatin coating amount in the photographic layers is within a range of 3 to 6 g/m^2, while present claims 1-11 do not includes such a requirement. Therefore, an embodiment with a total gelatin coating amount in the photographic layers of, e.g., 2 g/m^2 could literally infringe present claims 1-11, but could not literally infringe claim 9 of the '174 patent.

Indeed, Applicant notes that since the present application is a divisional application of the application which issued as the '174 patent and was filed as a result of a restriction requirement made in the application which issued as the '174 patent, the present claims cannot even be rejected for obviousness-type double patenting over any of the claims of the '174 patent.

In view of the above, Applicant submits that the present claims should not be rejected for double patenting, and withdrawal of this rejection is respectfully requested.

Anticipation Rejection

On page 2 of the Office Action, in paragraph 3, claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Sasaki et al. (U.S. Patent No. 6,780,579).

In response, Applicant notes that the present application claims priority from JPA No. 2002-96657 filed in Japan on March 29, 2002, while the 35 U.S.C. 102(e) date of Sasaki et al is its March 25, 2003 U.S. filing date. Accordingly, Applicant submits herewith a sworn translation of the priority application for the present case to antedate Sasaki et al and remove it from the prior art.

Thus, Applicant submits that the present invention is not anticipated by Sasaki et al, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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